

## REMARKS

Entry of the foregoing amendments to the application is requested on the grounds that the claims, as amended, patentably distinguish over the cited art of record or, alternatively, place the application in better condition for appeal. The claims more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. No new matter has been added. The claims, as amended, are believed to avoid the rejections applied in the Final Office Action for reasons set forth more fully below.

The Final Office Action of October 1, 2008 has been received and carefully reviewed. It is submitted that, by this Response, all bases of rejection are traversed and overcome. Upon entry of this Response, claims 1-25 remain in the application. Reconsideration of the claims is respectfully requested.

Claims 1-25 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. The Examiner asserts that Applicants' specification as filed does not provide a basis for the recitation "only one resin." The Examiner further asserts that the exclusion of other resins is new matter and not supported by the specification.

Applicants respectfully disagree, and again submit that the recitation of "only one resin" in claim 1 is fully supported by Applicants' specification as filed for the reasons set forth in Applicants' amendment dated June 18, 2008. In general, to satisfy the written description requirement under 35 U.S.C. § 112, first paragraph, "each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure" (see MPEP § 2163.05).

To reiterate, Applicants' specification as filed, at page 2, line 28, states, "... from 0.5 to 3% of **one** or more water-soluble polyurethane" (emphasis added). Applicants' specification further states that "[t]he ink compositions include from 0.1 to 5%, preferably from 0.5 to 3% water-soluble **polyurethane**. In certain **embodiments**, the ink compositions **may** include a mixture of **two or more** different polyurethanes, e.g., 2, 3, 4, or 5 different polyurethanes." (Emphasis added; page 3, lines 13-16 of Applicants' specification as filed.) Thus, in an **embodiment**, Applicants' ink composition includes

**only one** polyurethane resin (i.e., other than two or more polyurethane resins, which is covered in **other embodiments**). Thus, the **embodiment** where the ink composition includes only one polyurethane is the **embodiment** covered by Applicants' independent claim 1.

As such, Applicants submit that the recitation of "only one resin" is clearly supported by Applicants' specification as filed. Furthermore, it is submitted that there is no provision in the MPEP that states that excluding, in the claims, other embodiments disclosed in the specification as originally filed is considered new matter. Accordingly, claiming the embodiment of only one resin (which is clearly taught in Applicants' specification as filed, as well as in the claims as originally filed), and not claiming other embodiments covering two or more resins (as also taught in Applicants' specification as filed) therefore would **not** be considered new matter.

For the reasons provided above, it is submitted that i) the recitation of "only one resin" in claim 1 is clearly supported by Applicants' specification as filed and ii) the exclusion of other embodiments of the ink composition from claim 1 is not new matter. As such, it is further submitted that the 35 U.S.C. § 112, first paragraph, rejection is erroneously based, and withdrawal of the rejection is again respectfully requested.

Claims 1-4, 6-10, 17-23 and 25 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Waki, et al. (U.S. Patent Publication No. 2004/0242726, an English equivalent of WO 03/097753). The Examiner still asserts that Waki teaches all of the elements of independent claim 1, including the recitation of "only one resin" in the claim. In support of his assertion, the Examiner argues that both resins taught in Waki may be polyurethanes. The Examiner further argues that the mixture of resins taught by Waki is a mixture of molecules and, thus, may be considered as being only one polymer. In support of this foregoing argument, the Examiner reasons that a polymer is simply a mixture of different molecules.

In response thereto, Applicants respectfully disagree that Waki discloses or teaches that both resins are polyurethanes. Waki discloses, in paragraph [0013], that the pigment dispersion contains a i) a water-soluble resin, and ii) a resin having a urethane and/or an amide bond. Examples of the water-soluble resin are set forth in

paragraph [0046] of Waki, **none** of which are polyurethanes. It is therefore submitted that the Examiner's argument that *both* resins in Waki are polyurethanes is clearly **unsupported** by the Waki reference itself. At most, Waki teaches that *one* of the resins may be polyurethane (i.e., the resin including the urethane bond).

It is further submitted that, even if the mixture of resins in Waki is considered to be only one polymer, Waki still fails to establish "only one resin, ***the only one resin being a water-soluble polyurethane***," as recited in independent claim 1 (emphasis added). Applicants direct the Examiner's attention to paragraph [0069] of Waki, which teaches that the mixture of the water-soluble resin and the resin including the urethane and/or the amide bond is used to form ***a dispersion having a pigment dispersed therein***. The mixture is subjected to a cross-linking treatment in order to achieve ***improved dispersion stability and gloss***.

For further clarification, claim 1 has been amended to recite, "from about 0.5 to 6% by weight of a ***self-dispersed*** pigment" (emphasis added). Support for this new recitation may be found at page 8, line 26 through page 9, line 2 of Applicants' specification as filed. Claim 2 is also amended in order to conform to amended claim 1.

In sharp contrast to the teachings of Waki, the polyurethane resin present in the ink composition defined in Applicants' amended claim 1 is **not** used to disperse a pigment, at least for the following reasons.

Submitted herewith is a Declaration pursuant to 37 C.F.R. § 1.132 of George Sarkisian and Xiaohe Chen, which states that it is generally known that a self-dispersed pigment (as denoted by its name) is dispersible without a dispersant. Thus, one skilled in the art would generally not include a dispersant in a composition including a self-dispersed pigment. In view thereof, it is submitted that one skilled in the art would conclude that the polyurethane resin recited in amended claim 1 ***is not a pigment dispersant***.

As stated in the Declaration filed concurrently herewith, Applicants' specification as filed further provides another embodiment of the ink composition (not covered by amended claim 1) that includes unmodified pigments dispersed in a dispersant (see page 9, line 12 through page 10, line 3 of Applicants' specification as filed). A list of

pigment dispersants that may be used to disperse the pigment in this embodiment of the ink composition is also provided at page 9, line 13 through page 10, line 3 of Applicants' specification as filed. Polyurethane is **not** included in this list of dispersants.

For the reasons stated above, it is submitted that Waki fails to teach all elements of amended claim 1. As such, it is further submitted that Applicants' invention as defined in amended independent claim 1, and in those claims depending ultimately therefrom, is not anticipated, taught, or rendered obvious by Waki, either alone or in combination, and patentably defines over the art of record.

Claims 5 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Waki. For the reasons stated above, Applicants submit that Waki fails to anticipate or render obvious independent claim 1, from which claims 5 and 24 depend. Applicants further submit that Waki fails to render obvious claims 5 and 24, at least because of their dependency from claim 1. As such, it is submitted that Applicants' invention as defined in these claims is not anticipated, taught, or rendered obvious by Waki, either alone or in combination, and patentably defines over the art of record.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Waki in view of Iu, et al. (U.S. Patent No. 6,102,998). For the reasons stated above, Applicants submit that Waki fails to anticipate or render obvious independent claim 1, from which claims 11 and 12 depend, and that Iu fails to supply the deficiencies thereof. Applicants further submit that the combination of Waki and Iu fails to render obvious claims 11 and 12, at least because of their dependency from claim 1. As such, it is submitted that Applicants' invention as defined in these claims is not anticipated, taught, or rendered obvious by Waki and Iu, either alone or in combination, and patentably defines over the art of record.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Waki in view of Ma, et al. (U.S. Patent No. 5,648,405). For the reasons stated above, Applicants submit that Waki fails to anticipate or render obvious independent claim 1, from which claims 13 and 14 depend, and that Ma fails to supply the deficiencies thereof. Applicants further submit that the combination of Waki and Ma fails to render obvious claims 13 and 14, at least because of their dependency from

claim 1. As such, it is submitted that Applicants' invention as defined in these claims is not anticipated, taught, or rendered obvious by Waki and Ma, either alone or in combination, and patentably defines over the art of record.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Waki in view of Elwakil (U.S. Patent No. 5,833,743). For the reasons stated above, Applicants submit that Waki fails to anticipate or render obvious independent claim 1, from which claims 15 and 16 depend, and that Elwakil fails to supply the deficiencies thereof. Applicants further submit that the combination of Waki and Elwakil fails to render obvious claims 15 and 16, at least because of their dependency from claim 1. As such, it is submitted that Applicants' invention as defined in these claims is not anticipated, taught, or rendered obvious by Waki and Elwakil, either alone or in combination, and patentably defines over the art of record.

In summary, claims 1-25 remain in the application. It is submitted that, through this Response, Applicants' invention as set forth in these claims is in a condition suitable for allowance. Should the Examiner believe otherwise, it is submitted that the claims as amended qualify for entry as placing the application in better form for appeal.

Further and favorable consideration is requested. If the Examiner believes it would expedite prosecution of the above-identified application, the Examiner is cordially invited to contact Applicants' Attorney at the below-listed telephone number.

Respectfully submitted,

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Dated: December 17, 2008  
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